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JAMES H. MCKENNEY
CLERK

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1900. 1901

No. 182 1900 36.

CLINTON E. WORDEN & CO.,
Petitioners,

vs.

CALIFORNIA FIG SYRUP COMPANY.

PETITION FOR WRIT OF CERTIORARI.

JOHN H. MILLER,
Counsel for Petitioners.

Pilgrim-Baker Co. Print, 49 Sansome St., S. F.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1900.

CLINTON E. WORDEN & CO. (a Corporation),

Petitioner,

vs.

CALIFORNIA FIG SYRUP COMPANY (a Corporation).

PETITION

Of Clinton E. Worden & Co. (a Corporation) for a Writ of Certiorari, requiring the Circuit Court of Appeals for the Ninth Circuit to certify to the Supreme Court of the United States for its review and determination the case of Clinton E. Worden & Co. et al., Appellants, vs. California Fig Syrup Company (a Corporation), Appellee, under the provisions of section 6 of an act to establish Circuit Courts of Appeal, and to define and regulate in certain cases the jurisdiction of the courts of the United States, and for other purposes, approved March 3, 1895.

To the Honorable the Supreme Court of the United States:

The petition of Clinton E. Worden & Co., a corporation, respectfully shows to this Honorable Court as follows:

1. That at all the times hereinafter mentioned, your petitioner Clinton E. Worden & Co. was and is a corporation created under the laws of the State of California and having its principal place of business at the city and county of San Francisco in the State of California; that at all said times the appellee, the California Fig Syrup Company, was and is a corporation created under the laws of the State of Nevada.

2. That heretofore, to wit, on June 1, A. D. 1897, the said California Fig Syrup Company filed its bill in equity against your petitioners in the Circuit Court of the United States for the Northern District of California, wherein it was alleged that for many years prior thereto said California Fig Syrup Company had manufactured and sold a certain liquid laxative medical compound under and by the name of "Syrup of Figs" or "Fig Syrup"; that said name had been adopted and appropriated by the said California Fig Syrup Company as a trademark for said medicine, and the same had been extensively used for that purpose, whereby the said California Fig Syrup Company had become entitled to hold and use the said words as a trademark for said medicine; further alleging that your petitioners had infringed upon the asserted right of the California Fig Syrup Company under said trademark by manufacturing and selling a liquid laxative medical compound under the name "Syrup of Figs" or "Fig Syrup," thereby injuring and damaging the said California Fig Syrup Company and interfering with its trade, and said bill prayed that an injunction be granted against your petitioners enjoining

and restraining them from making, selling, or offering for sale any liquid, laxative preparation under the name "Syrup of Figs" or "Fig Syrup," or under any name in colorable imitation thereof, and from making, selling, or offering for sale any liquid, laxative medical preparation put up in bottles, boxes, or packages so similar in form and appearance to those used by the California Fig Syrup Company as to be calculated to deceive the public, and for various and sundry other forms of relief, including an accounting of the gains, profits, and advantages alleged to have been realized by your petitioners from the sale of their medicine under said name.

3. That your petitioners duly appeared in said case by their solicitors, and on April 14, A. D. 1898, filed their answer to the bill of complaint, denying, among other things, that the California Fig Syrup Company had any right, title, or property in and to said words "Syrup of Figs" or "Fig Syrup" as a trademark, on the ground and for the reason that the said medicine contained no appreciable quantity of figs or the juice or syrup of the figs, and was, therefore, deceptive and fraudulent, and an imposition upon the public, and that said words could not lawfully be appropriated as a trademark, and that the asserted and alleged trademark therein was utterly void and of no effect.

4. That thereafter, to wit, on May 2, A. D. 1898, a replication to said answer was duly filed, and the case being thus at issue, voluminous proofs were taken by both sides, and after a final hearing thereon, to wit, on June 7, 1899, an interlocutory decree was made and en-

tered in said case by the Circuit Court of the United States for the Northern District of California, wherein, among other things, it was ordered, adjudged, and decreed that the words "Syrup of Figs" or "Fig Syrup" as applied to a liquid, laxative medical compound by the California Fig Syrup Company, was a good and valid trademark and was the property of the California Fig Syrup Company, and that no other person had any right or authority to use said words in connection with a liquid, laxative medical compound without the consent of the said California Fig Syrup Company, and it was further ordered, adjudged, and decreed that a perpetual injunction be issued out of and under the seal of the court enjoining and restraining your petitioners and each of them, their agents, clerks, and workmen, from making, manufacturing, or using, or selling, or offering for sale, or in any way disposing of a liquid, laxative medicine or preparation under the name "Syrup of Figs" or "Fig Syrup," or under any name in colorable imitation thereof, and from making, selling, or offering for sale any medical, liquid, laxative preparation put up in bottles, boxes, or packages similar in form and arrangement to those used by the California Fig Syrup Company, or so closely resembling the same as to be calculated to deceive the public, and also from using the name "Fig Syrup Company" or any name whereof the words "Fig Syrup" or "Syrup of Figs Company" form a part as a business name in connection with the manufacture of a liquid, laxative preparation, and it was further decreed that your petitioners account for damages and

profits and costs of suit, the same to be ascertained on a reference to the standing master of the Court.

5. That thereafter, in due and proper season, an appeal was prosecuted by your petitioners to the Circuit Court of Appeals for the Ninth Circuit from the said interlocutory decree, and all necessary and proper steps were taken for the prosecution of said appeal, and the hearing of the same.

6. That in due and proper season said appeal came on to be heard and the same was heard by the said Circuit Court of Appeals for the Ninth Circuit, and after a hearing thereof, to wit, on May 21, A. D. 1900, the interlocutory decree appealed from was affirmed by said Circuit Court of Appeals, and a decree to that effect was thereupon entered; that the Judges presiding at the hearing of said case and participating in the decision were the Circuit Judges, Honorable W. B. Gilbert and the Honorable Erskine M. Ross, and the District Judge, Honorable Thomas P. Hawley; that the Honorable Erskine M. Ross, Circuit Judge, dissented from the opinion and decree of said Circuit Court of Appeals, and the affirmance of the decree appealed from was effected by the votes of the other two judges; that the opinion of said Circuit Court of Appeals in said case is found reported in volume 102 of the Federal Reporter, between pages 334 and 338.

7. That a true and correct transcript of the record on appeal in said case, together with a copy of the decree of the said Circuit Court of Appeals affirming the decree appealed from, and also a copy of the opinion of said

Circuit Court of Appeals rendered thereon are herewith produced and filed in this court.

8. And your petitioners further show unto your Honors that heretofore, to wit, on March 6, 1895, there was pending in the Circuit Court of the United States for the District of Massachusetts a suit in equity, wherein this same California Fig Syrup Company was the complainant and one Putnum was the defendant; the object of the said suit was the same as the object of the suit of the California Fig Syrup Company against your petitioners, to wit, to obtain an adjudication that the words "Syrup of Figs" and "Fig Syrup" as applied to a liquid, laxative medicine was a good and valid trademark, that the California Fig Syrup Company was the owner thereof, and that an injunction be issued against the defendants from infringing upon the same; that said suit against Putnum came on regularly to be heard before his Honor Judge Colt in the United States Circuit Court for the District of Massachusetts, and on March 6, 1895, a decree was entered therein wherein it was adjudged and decreed that the said words "Syrup of Figs" and "Fig Syrup" did not and could not under the law constitute a valid trademark as applied to said liquid, laxative medical compound, in that the said compound contained no appreciable quantity of fig juice, and was, therefore, deceptive and fraudulent; that the opinion of his Honor Judge Colt in that case is reported in volume 66 of the Federal Reporter at page 750; and thereupon the bill of complaint was ordered dismissed and a decree to that effect entered accordingly; that thereafter an appeal from said

decree was duly prosecuted by said California Fig Syrup Company to the Circuit Court of Appeals for the First Circuit, where the same was heard by that court, consisting of their Honors Judges Putnum, Nelson, and Aldrich, and the decree was affirmed, the opinion affirming said decree being reported in volume 69 of the Federal Reporter, at page 741.

9. And your petitioners further show unto your Honors that heretofore, to wit, on April 1, 1895, there was pending in the Circuit Court of the United States for the Eastern District of Michigan a suit in equity wherein this same California Fig Syrup Company was complainant and one Stearns was defendant. that the object of said suit was identically the same as the object of the suit against your petitioners, to wit, to establish the validity of the words "Syrup of Figs" and "Fig Syrup" as a valid trademark applied to a liquid, laxative, medical compound and to enjoin the infringement thereof; that after a full trial of the case and an exhaustive hearing by his Honor Judge Swan, it was ordered, adjudged, and decreed that the said words were not a valid trademark, in that the same were fraudulent and deceptive, and thereupon the bill of complaint was dismissed with costs; that the California Fig Syrup Company duly appealed from said decree to the Circuit Court of Appeals of the Sixth Circuit, and after a full hearing by that court before their Honors Judges Taft, Lurton, and Hammond, the decree appealed from was affirmed.

10. That by reason of the premises it is the established law in the First Circuit and in the Sixth Circuit that the

words "Syrup of Figs" and "Fig Syrup" as applied to a liquid, laxative, medical compound by the California Fig Syrup Company is deceptive and fraudulent, and for that reason not a valid trademark, and no one can be enjoined from using it, but by the decision of the Court of Appeals for the Ninth Circuit directly the opposite rule of law has been established, and your petitioners have been enjoined from using the said words in connection with a liquid, laxative, medical compound, and your petitioners therefore show, as reasons why the writ herein asked for should be granted, that the question is one of gravity and importance within the ruling of this court in the case of Lau Ow Bew, 141 U. S. 587, and other kindred decisions of this court, and that the question has been differently decided on substantially the same state of facts by different Circuit Courts of Appeals of the United States, to wit, by the Circuit Court of Appeals for the First and Sixth Circuits against the validity of the trademark, and by the Circuit Court of Appeals of the Ninth Circuit in favor of its validity, and therefore a ruling of this court is desired in the interest of uniformity of decision within the ruling of this court in the case of Lau Ow Bew aforesaid, and also in the cases of In re Wood, 143 U. S. 202 American Construction Co. vs. Jacksonville Ry. Co., 148 U. S. 372, and many other kindred cases.

11. That the questions on which a ruling of this court is desired are as follows: (1) Are the words "Syrup of Figs" or "Fig Syrup," when applied to a liquid, laxative, medical compound which contains no appreciable quantity of figs or fig juice, misleading and deceptive? (2) Can

the words "Syrup of Figs" or "Fig Syrup" be lawfully appropriated as a trademark for a liquid laxative medical compound which contains no appreciable quantity of figs or fig juice? (3) Are the words "Syrup of Figs" or "Fig Syrup," when used upon a medicinal preparation to be taken in small doses, and when accompanied by descriptive matter printed upon the package indicating that the medicinal properties claimed for the remedy are not derived from figs, but from the laxative principles of plants known to act most beneficially, calculated to mislead and deceive purchasers to such an extent as to deprive the manufacturer of the right to protection in the exclusive use of said names as a fanciful designation of his product, it being shown that such product in fact contains so little fig juice as to have no appreciable effect either medicinally or otherwise, and that no such preparation as "Syrup of Figs" is known to the drug trade? (4) Which of the conflicting decisions of the different circuits is correct—that of the Court of Appeals of the Ninth Circuit, holding that the words "Syrup of Figs" or "Fig Syrup" are a lawful trademark, or that of the Court of Appeals for the First Circuit and Sixth Circuit holding to the contrary? (5) Is the decree of the United States Circuit Court of Appeals for the Ninth Circuit affirming the decree of the United States Circuit Court for the Northern District of California, granting a perpetual injunction against Clinton E. Worden & Co. from making, using, selling, or offering for sale a liquid, laxative, medicine under the name "Syrup of Figs" or "Fig Syrup," good and sound in law?

Wherefore, your petitioners respectfully pray that a writ of certiorari be issued out of and under the seal of this Court directed to the Circuit Court of Appeals of the United States for the Ninth Circuit, commanding said court to certify and send to this court, on a day certain to be therein designated, a full and complete transcript of the record and all the proceedings of the said Circuit Court of Appeals in the case of Clinton E. Worden & Co. et al., Appellants, vs. California Fig Syrup Company, a Corporation, Appellee, No. 564, as identified by the transcript of the record, to the end that the said case may be reviewed and determined by this court as provided by section 6 of the act of Congress entitled "An act to establish Circuit Courts of Appeal and to define and regulate in certain cases the jurisdiction of the courts of the United States, and for other purposes," approved March 3, 1891; and that your petitioners may have such other and further relief and remedy in the premises as to this Court may seem meet and appropriate and in comformity with the said act; and that the said decree of the said Circuit Court of Appeals of the Ninth Circuit in the said case be reversed, and the said suit against your petitioners be ordered dismissed with judgment for their costs.

And your petitioners will ever pray, etc.

CLINTON E. WORDEN & Co.
By CLINTON E. WORDEN,
President.

JOHN H. MILLER,
Solicitor and Counsel for Petitioners.

United States of America,
Northern District of California. } ss.

John H. Miller, being duly sworn, says that he is the solicitor and counsel for the petitioners above named, and as such has had personal charge for said petitioners of the case in the foregoing petition mentioned in the Circuit Court of the United States for the Northern District of California, and in the Circuit Court of Appeals of the United States, for the Ninth Circuit; that he has read the said petition and knows the contents thereof, and that the facts therein stated are true to the best of his information and belief.

JOHN H. MILLER.

Subscribed and sworn to before me this 22nd day of Oct., 1900. F. D. Monckton
Clerk U.S. Circuit Court of Appeals for the Ninth Circuit.

Certificate of Counsel.

I hereby certify that I am the counsel for petitioners in the foregoing petition; that I have carefully examined the said petition on application for a writ of certiorari, and that, in my opinion, the same is well founded, and the case is one in which the prayer of the petitioner should be granted by this court.

JOHN H. MILLER,
Counsel for Petitioners.

Notice.

To Warren Olney, Esq., Counsel for California Fig Syrup Company:

Take notice that on Monday, the 12 day of November A. D. 1900, on the opening of court, or as soon thereafter as the matter can be heard, I shall move the Supreme Court of the United States, at the courtroom thereof in the city of Washington and the District of Columbia, that the foregoing petition for a writ of certiorari be granted.

Dated at San Francisco this 22nd day of Oct., A. D. 1900.

JOHN H. MILLER,
Counsel for Petitioners.

Copy of the foregoing petition and of the record admitted at San Francisco, Oct. 22, 19

Warren Olney
Counsel for Appellee